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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/020,248

12/18/2001

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21171 7590 08/20/2007  
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EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

08/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/020,248	<b>Applicant(s)</b> MATSUI ET AL.	
	<b>Examiner</b> Michael Bekerman	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This action is responsive to papers filed on 5/29/2007.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 20, this claim recites the limitation "storing at least one of a purchase date and a quantity purchased". The claim then recites "utilizing the purchase date and the quantity purchased". This is unclear. The claim requires only one of the 2 limitations, and in the next step requires both.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1, 2, 10-13, 15-17, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Bernstein (U.S. Pub No. 2002/0107730).** Bernstein teaches a merchant-to-merchant referral system that includes all of the limitations recited in the above claims.

**Regarding claims 1, 10, 11, 15-17, and 20,** Bernstein teaches storing product information including product name and attribute for many different products (or product groups) (Paragraph 0017), accepting selection of a product from a merchant by a consumer (Paragraph 0025), assigning a correspondence between a consumer identifier and the product (transaction) (Paragraph 0023), and providing to the consumer a recommendation of a different product from a different merchant based on the first selected product (Paragraphs 0014, 0016, and 0023). Bernstein also teaches the system and method as being implemented at a physical vendor as well as through the Internet (Paragraph 0013). To link similar products to each other, product attributes must inherently be stored in the system. Bernstein teaches the system as comprising any number of vendors and any number of customers (and thus, inherently more than 2 products) (Paragraph 0010). For a customer purchase history to be present, there must be a quantity purchased of at least 1 stored.

**Regarding claims 2, 12,** Bernstein teaches providing selected product information (purchase history) and the consumer identifier (consumer list) to a participating (second) vendor (Paragraph 0018).

**Regarding claim 13,** Bernstein teaches providing consumer information only in summary form (Paragraph 0019). This represents a disclosure level.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein (U.S. Pub No. 2002/0107730).**

Regarding claim 9, Bernstein doesn't specify the ability for a merchant to update product information. Since Bernstein teaches the product information as being available on the system, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow merchants the ability to alter that information at a later date in case the product information changes.

**Claims 3-8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maritzen (U.S. Pub No. 2003/0220841) in view of Herz (U.S. Patent No. 5,754,938).**

Regarding claims 3 and 14, Bernstein teaches the user's identity as being kept private from merchants on the system by using a customer information summary (Paragraph 0019) and a customer identifier (Paragraph 0023). Bernstein also teaches that buyers have a right to privacy (Paragraph 0005). Bernstein doesn't specify the identifier as varying for each merchant. Herz teaches the ability of a user to vary his

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information per merchant (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to create a different identifier for each merchant in the interest of enhancing consumer privacy even further between specific merchants.

**Regarding claim 4**, Bernstein teaches authenticating the redeemed promotional materials (Paragraph 0022). Once this authentication takes place, the purchase will be added to the purchase history of the consumer and this reads on storing a correspondence between the user identifier and the second product.

**Regarding claim 5**, Bernstein teaches redemption of the promotional materials (Paragraph 0022). This inherently reads on a payment process.

**Regarding claims 6-8**, Bernstein teaches the system as comprising any number of vendors and any number of customers (and thus, inherently more than 2 products) (Paragraph 0010). Thus, the referral system of Bernstein would similarly continue as in claims 1-3 for a third merchant. Thus, these claims would be rejected under the same basis as those claims.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MB

Jeffrey D. Carlson  
